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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,473	09/18/2000	Hugh Sharkey	14170-043002 / 25-31-0023	6257
7590 11/22/2006			EXAMINER SHAY, DAVID M	
Joel R. Petrow, Esq. Chief Patent Counsel Smith & Nephew, Inc. 1450 Brooks Road Memphis, TN 38116			ART UNIT 3735	
DATE MAILED: 11/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,473

Applicant(s)

SHARKEY

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 14, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Applicant has amended the section of the specification identifying applications which are relied upon for continuity under 1.120. This amendment is objected to as inaccurate. The contents of the instant application and 08/696,051 (hereinafter “the parent”) appear to be the same. However, this application does not claim the parentage of the instant application, and thus this application cannot be properly termed a “continuation” thereof, since the parent claims it is a “continuation” and that it’s specification was originally filed as the specification of 08/888,359, which also claims to be a “continuation” of 08/390,873. Thus asserting that the instant case is a “continuation of 08/696,051 and a CIP of 08/390,873, of which 08/696,051 is also purported to be a “continuation” is improper.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not consistently identify the applications under which the benefit of 35 U.S.C. 120 is being claimed.

A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Applicant argues that Sand ('709) teaches away from the use of RF energy at column 3, lines 11-22. The examiner respectfully notes that in this passage, Sand ('709) teaches away from the use of RF energy to shrink **corneal** collagen, as clearly set forth in the cited passage, there is no hint that the variation in topography of a few microns – a distance which yields a huge change

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in refractive performance of the cornea is problematic for vascularized tendons, which are hundreds of microns in diameter. It is also further shown by Anderson et al to be an acceptable energy to heat tissue such as tendons. Applicant disagrees. However, applicant provides no reasoned basis for the traversal of the examiner's stated rational. Applicant simply restates the previous argument, using this as the basis for the asserted criticality of the energy Sand teaches in the preferred embodiment of the invention described therein. Absent a factual basis upon which to refute the reasoning of the examiner, these arguments, standing alone, are not convincing.

Applicant proffers the disclosure of Sand relating to problems with confining the peak temperature to the stroma, while maintaining the upper and lower layers of the cornea at acceptably lower temperatures. However, there is no evidence of record to show any similar problem exists with shrinking tendons or ligaments; there is no indication of a three layer structure, wherein the upper and lower layers cannot tolerate the shrinkage temperature. To the contrary, Anderson discloses acting on of the entire cross- section of tissue, necessarily affecting any and all surface and interior layers, without any loss of functionality or other detrimental effects. Following applicant's theory, one of ordinary skill in the art would also be discouraged from using a laser to shrink the cornea, since Sand reports problems with epithelial necrosis with the use of lasers (see column 3, lines 32-42). Thus these arguments are not convincing.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 57-66 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Anderson ('216). Sand ('709) teaches a method such as

claimed except the use of RF, use of painting strokes, and use on patellar tendons per se.

Anderson ('216) teaches equivalence of RF energy and laser energy for heating tissue. It would have been obvious to artisan of ordinary skill to employ RF energy in the method of Sand ('709) since this is not critical and these are equivalent for tissue heating, as taught by Anderson ('216) to employ the method on patellar tendons, since Sand ('709) does not discuss avoiding these structures when heating tendons attaching the long bones; to employ a painting motion, since this would allow a substantial length of the tendon to be treated all at once, and to deflect the probe, as taught by Anderson et al, since Sand ('709) teaches no particular technique to reach the internal tissues which are contemplated to be treated, and since this is not critical, and to provide an insulated region, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and will prevent the RF energy from being applied to the surgeon or to adjacent tissue which are not to be treated, thus producing a method such as claimed.

Claim 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Anderson ('216) as applied to claims 57 and 61-66 above, and further in view of Makower et al. Makower et al teach the desirability of insulating tissue that is not desired to be affected by the heat application. It would have been obvious to the artisan of ordinary skill to insulate portions of the tissue which are not desired to be affected since this would prevent undesirable heating in the tissue, thus producing a method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,458,596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,785,705. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,954,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,068,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,169,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,246,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,391,028. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,482,204. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

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Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-93 of U.S. Patent Application No. 08/714,987 in view of Sand ('709). Sand ('709) teaches the use of applied surface applied energy to shrink tendon tissue. It would have been obvious to the artisan of ordinary skill to employ the method claimed in the shrinking of tendons, since this will enable musculoskeletal and cosmetic surgeries, as taught by Sand ('709), thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

Claims 57-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 13, 14, 16, 18-22 of copending Application No. 11/112,164 in view of Sand ('709). Sand ('709) teaches the use of applied surface applied energy to shrink tendon tissue. It would have been obvious to the artisan of ordinary skill to employ the method claimed in the shrinking of tendons, since this will enable musculoskeletal and cosmetic surgeries, as taught by Sand ('709), thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed September 14, 2006 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Applicant's arguments with respect to claim 68 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

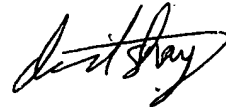
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330